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REMARKS

Claims 1-30 are pending in the application. Claims 1-30 were rejected. Claims 1, 6, 7, 13, 14, 16-19, 21-23, and 30 have been amended herein.

5 **Response to "Response to Arguments"**

Applicant would like to respond to the "Response to Arguments" section on pages 7 and 8 of the Final Office Action.

Regarding page 7, paragraph 6, Applicant respectfully submits that the Examiner is reading and responding to only portions of Applicant's arguments. For example 10 fragments of sentences or paragraphs are selected, isolated, and presented as if they are complete statements. For example, Applicant does not "repetitively argue[s] that Nakai does not describe or teach an identity module coupled to a processor of the portable communication device (see e.g. page 11, last two paragraphs, starting line 16, of the response)". (page 7, paragraph 6 of the Final Office Action). That is a partial 15 restatement of what the Applicant wrote.

Applicant reiterates the cited passage of the response below:

Regarding claim 1, Applicant respectfully submits that Nakai does not disclose a portable communication device comprising an identity module removeably coupled to the processor, wherein information of the 20 identity module controls operation of the device, wherein the processor receives binding information including identification information from components of the device and subscriber information from the identity module, forms an association between the device and the module by assigning a device identification (DID) to the binding information, 25 generates at least one binding file in a memory area of the module, and stores the device identification and the binding information in the binding file (underlining indicates emphasis added). Thus, Applicant submits that Nakai does not anticipate claim 1.

Applicant submits that Nakai describes a mobile telephone that 30 permits attaching and detaching of a memory card as an external memory. However, Nakai does not describe or teach an identity module coupled to a processor of the portable communication device. Furthermore, Nakai does not disclose that the memory card contemplates or includes an identity module. Therefore, Nakai does not describe or teach a portable

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communication device comprising an identity module removeably coupled to the processor as claimed in claim 1.

Please note the following excerpt of the above-quoted passage:

5 ...an identity module removeably coupled to the processor, wherein information of the identity module controls operation of the device, wherein the processor receives binding information including identification information from components of the device and subscriber information from the identity module...*(emphasis removed)*.

10 Applicants state many words beyond "an identity module removeably coupled to the processor", including "wherein information of the identity module controls operation of the device, wherein the processor receives binding information including identification information from components of the device and subscriber information from the identity module". *(emphasis added)*. Applicants respectfully assert that Nakai does not teach or suggest such an identity module. Nakai is restricted to teaching a memory card (for 15 example 202) that has content which can be protected, etc. Nakai mentions a SIM card incidentally at paragraph 47:

20 Where the terminal telephone number and the device ID are stored in a storage unit detachable from the mobile telephone, such as an SIM card or a UIM card, a user having an SIM card or a UIM card can decipher the contents of the memory card at any of a plurality of terminals.

25 This passage states that, if the terminal telephone number and the device ID are stored on the SIM card or UIM card, a user having an SIM card or a UIM card can decipher the contents of the memory card at any of a plurality of terminals. The SIM card or UIM card is not shown or discussed further; it is merely a possible source of information that is used in the encipher/decipher process that controls access to content 30 on the memory (e.g., memory 103 or RAM 207). There is absolutely no teaching regarding, for example, a processor receiving binding information including identification information from components of the device and subscriber information from the identity module. That is because Nakai is not concerned with any association between the device and the identity module. For example, Nakai provides no teaching

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whatsoever regarding subscriber information as claimed. Nakai is only concerned with protecting or controlling access to content, "such as a call melody and wallpaper [that can be exchanged] between the mobile telephone 101 and the memory card 103". (paragraph 35).

5 The focus of Nakai is storing content on the memory device (e.g., 103, or RAM 207. Memory 103 and RAM 207 are NOT identity modules, but rather memories to store content (such as call melodies and wallpaper) and various protection mechanisms for controlling access to the content.

10 Regarding page 8, paragraph 7 of the Final Office Action, Applicants respectfully submit that the Examiner is misunderstanding and/or misstating Applicant's argument. The Examiner states that the Applicant fails to show certain features of the invention upon which he relies (citing enciphered title key and/or enciphered content). Applicant does not "rely on" enciphered title key and/or enciphered content. Nor does Applicant seek to read such a limitation into the claims. The cited passage is reiterated below:

15 Applicant further submits that Nakai describes, during operations to decipher and read contents from the memory card, a ciphering program that reads an enciphered title key and enciphered content from the memory card. However, Nakai does not disclose that the enciphered title key and/or the enciphered content include subscriber information.

20 Furthermore, as described above, Nakai does not disclose that the memory card includes an identity module. Therefore, in contrast to claim 1, Nakai does not describe a processor that receives subscriber information from the identity module. For this reason, claim 1 is not anticipated by Nakai.

25 Applicant very clearly states: "in contrast to claim 1, Nakai does not describe a processor that receives subscriber information from the identity module. For this reason, claim 1 is not anticipated by Nakai." Therefore, Applicants are stating that "Nakai does not disclose that the enciphered title key and/or the enciphered content include subscriber information." Applicant is stating what the reference lacks- not seeking to read 30 limitations into the claims that are not supported by the specification, or to argue claim limitations that are not supported by the specification. Applicant respectfully asserts that all of the claims are fully supported by the specification, and that Applicant is arguing the claim language and pointing out what the reference lacks. Applicant continues to

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maintain that the Nakai does not teach a processor that receives subscriber information from the identity module, and therefore Nakai does not anticipate the claims.

Regarding page 8, paragraph 8 of the Final Office Action, Applicant fails to understand what the Examiner is seeking to convey in the paragraph. Applicant respectfully reminds the Examiner that the Applicant may be his own lexicographer. The term "association" is clearly described and illustrated in the specification (see, for example, page 5, lines 14-23 of the specification). Therefore, it is not permissible to rely solely on a dictionary definition. Applicant submits that the term as used is not, as asserted, merely suggestive of an abstract relationship.

10 The passage of the response cited by the Examiner is reiterated below:

15 Applicant further submits that, in contrast to claim 1 which forms an association between the device and the module, Nakai describes forming an association between the mobile telephone (telephone number) and the content stored in the mobile telephone RAM. Nakai forms an association between the device and the content because the ciphering program of Nakai acquires content from the telephone RAM, enciphers the content using only the device telephone number, and stores the enciphered content on the memory card. Nakai therefore does not use any information of the memory card in the operations to encipher content for storage on the memory card. Nakai therefore does not disclose the device of claim 1 because Nakai does not disclose receiving binding information that includes subscriber information from the identity module, and forming an association between the device and the module by assigning a device identification (DID) to the binding information. For this reason, 20 claim 1 is not anticipated by Nakai.

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30 Please note the passage "forming an association between the device and the module by assigning a device identification (DID) to the binding information", which concretely states the relationship as being formed by the assignment of a DID to the binding information.

Applicant argues that "Nakai does not disclose receiving binding information that includes subscriber information from the identity module, and forming an association between the device and the module by assigning a device identification (DID) to the binding information". Applicants state that the claimed subject matter is particularly and

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uniquely distinguished from the applied prior art regardless of how "association" is understood. For example, Nakai does not disclose receiving binding information that includes subscriber information from the identity module. For this reason alone, Nakai does not anticipate claim 1.

5 **Rejections under 35 U.S.C. §102**

Claims 1-12 are rejected under 35 U.S.C. § 102(e) as being anticipated by Nakai (United States Patent Application Publication number 2004/0260923 A1), hereinafter "Nakai". Applicant respectfully submits that the claims are patentably distinct from Nakai for the reasons stated below.

10 Applicant respectfully submits that Nakai describes a content processing device that permits, when contents are to be stored in a recording medium, only a specified device to read out the stored contents of the recording medium (Nakai, paragraph 0008). The content processing device described in Nakai is a mobile telephone (Nakai, paragraph 0034). Nakai generally uses the telephone number of the mobile telephone as 15 a ciphering key for use in enciphering the contents to be stored on the recording medium. The contents, once enciphered and stored in the recording medium by the device, can only be read from the recording medium by the device used to store the contents (Nakai, paragraphs 0011-0014).

20 More specifically, Nakai describes a mobile telephone that permits attaching and detaching a memory card as an external memory, where the mobile telephone can read and write into and out of the memory card. Nakai describes this invention as enabling the user to use a user interface of the mobile telephone to exchange contents, such as a call melody and wall-paper between the mobile telephone and the memory card. See Nakai, paragraph 0035.

25 Nakai describes operations involving storing content on the memory card as follows. A ciphering program of the mobile telephone acquires the telephone number from a read-only memory (ROM) of the telephone, and generates a title key using the telephone number. The ciphering program then acquires content from a random access memory (RAM) of the telephone and enciphers the content using the title key. The

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ciphering program also enciphers the title key using a ciphering key generated from the telephone number. The ciphering program then stores into the memory card the enciphered content and the enciphered title key. See Nakai, paragraphs 0036-0038, and Figures 2 and 3.

5 Nakai describes operations involving reading content from the memory card as follows. The ciphering program of the mobile telephone acquires the telephone number from the telephone ROM and generates a ciphering key from the telephone number. The ciphering program also reads the enciphered title key from the memory card and deciphers the enciphered title key using the generated ciphering key. The ciphering 10 program then reads the enciphered content from the memory card and deciphers the enciphered content using the deciphered title key. The ciphering program stores the deciphered content in the telephone RAM from which it can be read or played by the telephone. See Nakai, paragraphs 0039-0040, and Figure 4.

15 Regarding claim 1, Applicant respectfully submits that Nakai does not disclose, teach or suggest an identity module removeably coupled to the processor, wherein information of the identity module controls operation of the device, wherein the processor generates a binding file that comprises binding information and a device ID (DID), wherein the binding information comprises identification information from components of the device and subscriber information from the identity module, as 20 claimed. Nakai simple fails to teach at least a processor that generates a binding file as claimed, that comprises binding information and a device ID (DID), wherein the binding information comprises identification information from components of the device and subscriber information from the identity module. Nakai completely lacks any teaching regarding using subscriber information in any way, much less as claimed. Therefore, 25 claim 1 is not anticipated by Nakai.

The Examiner states that Nakai teaches an identity module 103, wherein information of the identity module controls operation of the device, etc. Applicant respectfully disagrees with this interpretation of the reference. The Examiner erroneously, or improperly, cites Figure 1, element 103, Figure 2, element 202, and

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paragraphs 18 and 47 with reference to an identity module. Figures 1 and 2 are described as clearly NOT showing an identity module. See, for example, paragraph 35, quoted below:

5 A mobile telephone 101 shown in FIG. 1 has a memory card I/F 102 permitting attaching and detaching (insertion and extraction of a memory card 103 as an external memory, and can read and write into and out of the memory card 103 inserted into that memory card I/F 102. This configuration enables the user to operate keys 105 according to a GUI displayed on a liquid crystal screen 104 and to exchange contents, such as 10 a call melody and wallpaper between the mobile telephone 101 and the memory card 103.

15 The memory card cannot operate the device - it is just a storage device - but the user can operate keys of the device to exchange contents, such as a call melody and 20 wallpaper between the mobile telephone 101 and the memory card 103. Therefore, memory card 103 is not an identity module as claimed.

Similarly, memory card 202, as described in paragraph 36 below, is the same as memory card 103.

20 FIG. 2 is a block diagram of the internal configuration of the mobile telephone 101 embodying the invention in this mode. In FIG. 2, reference numeral 201 denotes a mobile telephone; 202, a memory card; 203, enciphered contents stored within the memory card 202; 204, 25 enciphered title keys derived from enciphering of the title keys in enciphering the contents 203; 205, a memory card I/F serving as the interface inputting and outputting between the memory card 202 and the mobile telephone 201; 206, a random access memory (RAM); 207, 30 contents stored in the RAM 206; 208, a read only memory (ROM); 209, the terminal telephone number of the mobile telephone 201 stored within the ROM 208; 210, a device ID permitting unique identification of the mobile telephone 201; and 211, a ciphering program for deciphering the 35 enciphered contents 203 within the memory card 202 and enciphering the contents 207 within the RAM 206 and storing the enciphered contents into the memory card 202. Incidentally, the enciphered contents 203 and the enciphered title keys 204 are matched to each other on a one-to-one basis in the memory card 202 so that the right enciphered title key 204 for deciphering a given enciphered content 203 can be identified.

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Applicants have cited and discussed paragraph 74 above and incorporate that discussion here. Applicant respectfully submits that the cited figures, and paragraphs of the reference clearly do not teach the claimed invention.

Claims 2-5 depend from claim 1 and include further limitations thereon.

5 Applicant therefore respectfully submits that claims 2-5 are similarly not anticipated by Nakai.

Regarding claim 6, Applicant respectfully submits that Nakai does not teach or suggest a communication device as claimed.

For example, Nakai does not teach or suggest a control subsystem that reads 10 identification information of the components and the identity module and, in response, dynamically links the device to the identity module by writing the identification information to a binding file of the identity module. Nakai does not suggest anything that writes to an identity module, much less anything that writes a binding file as claimed into an identity module. In fact, Nakai teaches away from the claim by teaching writing to a 15 RAM or memory card only (e.g., RAM 207 and memory card 202). Therefore, Applicant respectfully submits that claim 6 is not anticipated by Nakai.

The Examiner states that Nakai teaches an identity module 103, wherein 20 information of the identity module controls operation of the device, etc. Applicant respectfully disagrees with this interpretation of the references. The Examiner erroneously, or improperly, cites Figure 1, element 103, Figure 2, element 202, and 25 paragraphs 18 and 47 with reference to an identity module. Figures 1 and 2 are described as clearly NOT showing an identity module. The Examiner's assertions regarding an identity module and citing Figure 1, element 103, Figure 2, element 202, and paragraphs 18 and 47 are identical to those made with reference to claim 1. Applicant incorporates the above response (with reference to claim 1) to the Examiner's assertions here with reference to claim 6.

Regarding claim 7, Nakai lacks at least the claimed means for generating a binding file in a memory area of the module and storing the device identification and the binding information in the binding file, so as to enable the device to access a

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communications network. Nakai does not provide any teaching regarding enabling the device to access a communications network. In fact, Nakai teaches away from the claimed invention by teaching enabling (or disabling) the device from playing content stored in the RAM or the memory card. Therefore, Applicant respectfully submits that 5 claim 7 is not anticipated by Nakai.

The Examiner states that Nakai teaches a "means for receiving (I/F 205), subscriber information from a module removeably coupled to the device (103 – Figure 1 / 10 202 – Figure 2; paragraph 0047". Applicant respectfully disagrees with this interpretation of the references. The Examiner erroneously, or improperly, cites Figure 1, element 103, Figure 2, element 202, and paragraphs 18 and 47 with reference to a module that stores subscriber information. Figures 1 and 2 are described as clearly NOT showing such a module. Applicant respectfully refers the Examiner to the discussion of Figure 1, element 103, Figure 2, element 202, and paragraphs 18 and 47 with reference to claim 1. The memory card does not, and is not intended to, store subscriber information in any 15 sense, including the meaning of subscriber information as understood by one of ordinary skill in the telecommunications arts. The memory card stores content (e.g., call melodies and wallpaper), as clearly stated in the reference.

Regarding claim 8, Nakai fails to disclose at least a personal communication device as claimed, including a processor wherein the processor receives binding 20 information including identification information from components of the communication device and subscriber information from the identity module wherein the processor transmits the binding information to the network components. Nakai provides absolutely no teaching regarding binding information as claimed, subscriber information as claimed, or transmitting binding information to the network components. Nakai does not have 25 anything whatever to teach regarding transmitting anything to network components, or any interaction between a network and the device. Nakai is restricted to detailing a memory card that can be inserted in a device for accessing content, and how to control that access. For purposes of Nakai's teaching, the "device" may as well be a portable CD

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player with no communications capabilities. Therefore, Applicant respectfully submits that claim 8 is not anticipated by Nakai.

The Examiner states that Nakai teaches an identity module 103, wherein information of the identity module controls operation of the device, etc. Applicant 5 respectfully disagrees with this interpretation of the references. The Examiner erroneously, or improperly, cites Figure 1, element 103, Figure 2, element 202, and paragraphs 18 and 47 with reference to an identity module. Figures 1 and 2 are described as clearly NOT showing an identity module. The Examiner's assertions regarding an identity module and citing Figure 1, element 103, Figure 2, element 202, and paragraphs 10 18 and 47 are identical to those made with reference to claim 1. Applicant incorporates the response to the Examiner's assertions here with reference to claim 8.

Rejections under 35 U.S.C. §103

Claims 13-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakai. Applicants submit that the rejections under 35 U.S.C. §103 are improper. MPEP 15 § 706.02(j) states:

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

20 (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

25 (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

5 Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

10 Applicant respectfully submits that the rejection does not set forth (A), (B), (C), or (D), as required, or provide an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

15 Although Applicant believes the rejection to be improper, Applicant will nonetheless respond to the specific rejection in the interest of leaving no doubt that Applicant is making a full and complete response to the Final Office Action. Applicant respectfully asserts that claims 13-30 would not have been obvious in view of Nakai.

20 With regard to claim 13, Applicants submit that Nakai provides no teaching or suggestion regarding a method for forming dynamic associations among portable identity modules and portable communication devices enabling the portable communications devices to access at least one communications network as claimed. Because Nakai does not disclose anything whatsoever to do with accessing a network (the content-playing and content-storing device just happens to be a phone in Nakai), one of ordinary skill would find no motivation to modify Nakai. Therefore, Applicant asserts that claim 13 would not have been obvious in view of Nakai.

25 With reference to claim 26, Nakai provides no teaching regarding determining if at least one of the device and the memory card are registered to provide service on the communication network by comparing the subscriber information with information of a binding file of the memory card. In fact, Nakai lacks any teaching relating to a device and/or a memory card being registered to provide service on a communication network. The content-playing and content-storing device just happens to be a phone in Nakai, but

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Nakai does not address anything to do with communications capability. Nakai further lacks any teaching regarding subscriber information or binding files. For these reasons one of ordinary skill in the art would find no motivation to modify Nakai as suggested. Therefore, Applicant asserts that claim 26 would not have been obvious in view of Nakai.

5 With reference to claim 30, Nakai provides no teaching regarding receiving identification information from a portable identity module coupled to a portable communication device; assigning a device identification to an association between the portable identity module and the portable communication device; or generating a binding state file in a memory area of the portable identity module. Nakai simply lacks any such
10 suggestion or teaching. The content-playing and content-storing device just happens to be a phone in Nakai. For these reasons one of ordinary skill in the art would find no motivation to modify Nakai as suggested. Therefore, Applicant asserts that claim 30 would not have been obvious in view of Nakai.

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Conclusion

In view of the foregoing Remarks, Applicant respectfully submits that the rejections under 35 U.S.C. §102 and §103 have been overcome, and their withdrawal is respectfully requested. Applicant submits that claims 1-30 are in condition for allowance. The allowance of the claims is earnestly requested. If in the opinion of Examiner Ramos-Feliciano a telephone conference would expedite the prosecution of the subject application, or if there are any issues that remain to be resolved prior to allowance of the claims, Examiner Ramos-Feliciano is encouraged to call Barbara Courtney at (408) 342-1902.

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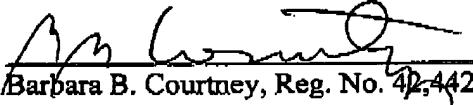
Authorization to Charge Deposit Account

Please charge deposit account 503616 for any fees due and not paid herewith in connection with this Office Action response.

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Respectfully submitted,
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